

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

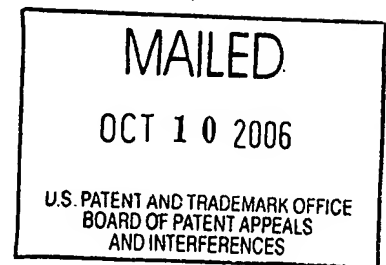
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Ex parte : FRANCIS DALY

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Application No. 10/823,951

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on September 19, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

**BACKGROUND**

**Final Rejection**

On June 17, 2005 a Final Rejection was mailed. The Final Rejection (Office Action Summary, pg. 1) states that, "claims 1, 3-38 are rejected under 35 U.S.C 103(a)..." However, the Detailed Action (pg. 2) that follows only discuss claims 1, 3-37. It is noted for claim 38 that "...the Examiner finds nothing in the Specification..." (pg 11). A review of the application reveals that

claim 38 was not properly addressed.

### **Appeal Brief**

A review of the Appeal Brief filed December 21, 2005, the Amendment and Response filed April 11, 2006 and the Amendment and Response filed May 23, 2007, reveals that all three communications were all defective, as they were not in compliance with 37 CFR § 41.37.

Correction is required.

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) **Real party in interest.** A statement identifying by name the real party in interest.

(ii) **Related appeals and interferences.** A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) **Status of claims.** A statement of the status of all the claims in the proceeding (*e.g.*, rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) **Status of amendments.** A statement of the status of any amendment filed subsequent to final rejection.

(v) **Summary of claimed subject matter.** A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each claim involved in the appeal, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) **Grounds of rejection to be reviewed on appeal.** A concise statement of each ground of rejection presented for review.

(vii) **Argument.** The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim.

(viii) **Claims appendix.** An appendix containing a copy of the claims involved in the appeal.

(ix) ***Evidence appendix.*** An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was

entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) **Related proceedings appendix.** An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or with any appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

MPEP § 1205.03 states in part the following:

In response to the Notice of Non-Compliant Appeal Brief (37 CFR 41.37) or the Office communication that requires an amended brief, appellant is required to file an amended brief that is either a complete new brief with the required corrections or a replacement section(s) as noted below:

(A) When the Office holds the brief to be defective solely due to appellant's failure to name the real party in interest as required by 37 CFR 41.37(c)(1)(i), an entire new brief need not, and should not, be filed. Rather, a paper identifying by name the real party in interest will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

(B) When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

It is required that Appellant submit a single complete Appeal Brief that complies with all the requirements of 37 C.F.R. § 41.37(c).

**EXAMINER'S ANSWER**

**Grounds of Rejection**

On February 26, 2007, an Examiner's Answer was mailed in response to the Appeal Brief received December 21, 2005. The section entitled Grounds of Rejection identifies that Claims 1, 3-34, 36 and 37 are rejected under 35 U.S.C 103(a) as being unpatentable over Otsuka et al. (US Patent 5,974,360) in view of Frank (US Patent 5,615,118), further in view of Kuntman (US Patent 5,077,558). The Examiner's Answer again does not properly address the rejection of claim 38. The Examiner's Answer mailed February 26, 2007, should be vacated and for purposes of clarification of the rejected claims, including claims 38 is required.

It is directed that the Examiner must first clarify the claims on rejection prior to mailing any Notice of Non-Compliance of the Appeal Brief, to enable the Appellant's Appeal Brief to fully comply with the requirements of 37 CFR 41.37.

Accordingly, it is

**ORDERED** that the application is returned to the Examiner:

- 1) vacate the Examiner's Answer mailed February 26, 2007, to clarify the claims on rejection;
- 2) hold Appellant's Amendment and Response, filed May 23, 2007, defective;

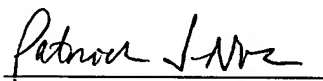
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3) require Appellant to file a Supplement Appeal Brief that is in compliance with 37 CFR § 41.37 (c);

4) for the Examiner to issue and mail an Examiner's Answer in response to any Supplemental Appeal Brief filed by Appellant; and

5) for such further action as may be appropriate

BOARD OF PATENT APPEALS  
AND INTERFERENCES



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PJN/tsj

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